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Docket 83581DAN
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Michael J. May

METHOD OF PRODUCING A
PACKAGE WRAPPER

Serial No. 10/075,976

Filed February 14, 2002

Group Art Unit: 3721

Examiner: Sameh Tawfik

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August 10, 2005
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Commissioner for Patents

P.O. Box 1450

Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith is Appellants' Appeal Brief for the above-identified application which is in response to a Notification of Non-Compliant Appeal Brief mailed July 12, 2005.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

Appellants hereby appeal to the Board of Patent Appeals and Interferences
from the Examiner's Final Rejection of claims 1-3 and 5-8, 23 and 24 which was
contained in the Office Action mailed December 23, 2004.

A timely Notice of Appeal was filed March 23, 2005.

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APPELLANT'S BRIEF ON APPEAL

I. Real Party In Interest

The real party in interest is Eastman Kodak Company, assignee of the inventor's entire interest.

II. Related Appeals And Interferences

None.

III. Status Of The Claims

Claims 1-3, 5-8, 23 and 24 stand finally rejected and are the subject of this appeal.

Claim 4 was canceled by the amendment filed on October 25, 2004.

Claims 9-22 and 25 stand withdrawn from consideration as directed to a non-elected invention pursuant to the restriction requirement made by the Examiner in the Office Action dated August 28, 2003, and the Applicant's election made in the communication dated September 9, 2003.

Appendix I provides a clean, double-spaced copy of the claims on appeal.

IV. Status Of Amendments

No amendments were made to the claims after the final rejection of December 23, 2005. In the Advisory Action dated March 22, 2005, the Examiner indicated that the subject matter of the response after final dated March 7, 2005, would be entered for appeal.

V. Summary of Claimed Subject Matter

A. Independent claim 1 is summarized as follows:

A method of producing a personalized package wrapper (52) (Fig. 10) that comprises a user submitted image (24) (see Fig. 2 and page 7, line 5-7), comprising: displaying the image (24) in a display area of an imaging device (10) (40, Figs. 1 and 4, and page 8, lines 1-4); providing a window (42) (Fig. 5) on the image to produce a windowed image (44) (Fig. 6), the window being movable relative to the image, and the windowed image comprising a portion of the image

(see page 8, lines 5-8); displaying a package wrapper image (48) (Fig. 7) that includes a representation of a portion of a package wrapper which includes the windowed image (44) (page 8, lines 16-17); selecting a package wrapper size (46, Fig. 7, page 8, lines 18-20); and performing a printing of the package wrapper, a transmitting of the package wrapper image, or a storing of the package wrapper image (Fig. 8, page 8, lines 24-30; page 9, lines 21-30).

B. Independent claim 8 is summarized as follows:

8. A method of producing a personalized package wrapper (22), comprising: providing an imaging device (10) having a display (12) for displaying an image (24) provided by a user (Figs. 1 and 4); providing a window (42) which is movable relative to the image (24) to produce a windowed image (44), with the windowed image being comprised of a portion of the image (24) (Figs. 5 and 6); forming a package wrapper image (48) which comprises a representation of a portion of a package wrapper with the windowed image (44) provided thereon (Fig. 7); displaying the representation of the portion of the package wrapper comprised of the windowed image (Fig. 7); selecting a package wrapper size (46, Fig. 7); and performing a printing of the package wrapper, a transmitting of the package wrapper image, or a storing of the package wrapper image (Fig. 8).

VI. Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection for review are:

(1) The rejection of claims 1-3, 5-8, 23 and 24 under 35 USC 103(a) as being unpatentable over Jennel in view of Hinton.

VII. Arguments

A. Rejection of claims 1-10 under 35 USC 103 based upon combined teachings of Jennel and Hinton.

i. Arguments for independent claim 1.

Claim 1 relates to a method of producing a personalized package wrapper that comprises at least one user submitted image. The method of claim 1 comprises the steps of displaying the user submitted image in a display area of an imaging device (see Fig. 4, image 40); providing a window on the image to produce a windowed image, with the window being movable relative to the image, and the windowed image comprising at least a portion of the image (see Fig. 4, window 42 on image 40, and windowed image 44 of Figs. 6 and 7); displaying a package wrapper image that includes a representation of at least a portion of a package wrapper that includes the windowed image thereon (see Fig. 7, portion of package wrapper 48); selecting a package wrapper size (see Fig. 7, selection means 46); and performing at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing of the package wrapper image (see pages 8-10 and Fig. 8).

The reference to Jennel relates to an arrangement in which images are pre-stored, and thus, is different from the present invention where unique images are provided by consumers at the time of creating a personalized package wrapper. More specifically, the reference to Jennel relates to a high volume arrangement in which a web of material can be partitioned into predetermined sections which can eventually be fabricated into individual packages. The invention of Jennel provides for an apparatus to print a color digital image on each section of a wrapper. For this purpose, in Jennel an electronically storable and retrievable digital image 36a or 36b is generated at an image generator 22. The image generator 22 may be at a site away from a printing site 24. The image generator 22 can be connected to the printing site via a data transfer device 28

capable of transmitting digitally generated images electronically. The digital printing system of Jennel permits the image 36a or 36b to be directly printed on a section of a web of packaging material. As noted on page 2, paragraph 3, of the Final Rejection dated December 23, 2004 (the Final Rejection), the reference to Jennel does not disclose that a "user submit an image to produce a windowed image nor the window being movable relative to the image". Therefore, the reference to Jennel does not show or suggest the steps of displaying a user submitted image in a display area of an imaging device; and providing a window on the image to produce a windowed image, with the window being movable relative to the image, and the windowed image comprising at least a portion of the image.

Also, on page 2, paragraph 3 of the Final Rejection, it is stated that Jennel discloses the step of "displaying at least a portion of a package wrapper which includes the image thereon" and reference is made to Figs. 1 and 2 and elements 26a and 26b of Jennel. Applicants respectfully disagree with this characterization of Figs. 1 and 2 of Jennel. Figs. 1 and 2 of Jennel disclose a digital printing system 20. In the embodiment of Figs. 1 and 2 of Jennel, an image 36a, 36b is shown on the display of the system 20. There is no showing or suggestion in Figs. 1 and 2 of Jennel that a portion of a package wrapper that includes an image thereon is to be shown on the display of the system.

On page 5 of the Final Rejection, it is stated that the reference to Jennel discloses a package wrapper image represented in a window image "via images 36a and 36b on display 22". Applicant notes that in Jennel, an image generator or display 22 is connected to a printing site 24 via a data transfer device 28. Figs. 1 and 2 of Jennel further show that downstream of printing site 24, a digital graphic image 36a, 36b can be printed. It is noted that each of the images 36a and 36b shown on material 26a and 26b are illustrated as a product of the printing site 24. There is no showing or suggestion in Jennel that a user utilizing the system of Jennel has an opportunity to display a package wrapper image that includes a representation of at least a portion of a package wrapper and a windowed image on the display. Therefore, absent Applicant's disclosure, there would be no showing or suggestion of the feature of the present invention as illustrated in, for example, Fig. 7 of the present application, where a windowed image 44 and a portion of a package wrapper 48 can be shown on a display. In Jennel, the full image 36a, 36b is shown on a display. Thereafter, the image is sent to a printing site 24 where the image 36a, 36b can be provided on package

wrapper 26b. That is, wrapper 26b and image 36a, 36b of Jennel are described and illustrated in Figs. 1 and 2 as being a product of the printing site. There appears to be no showing or suggestion in Jennel that the display is to display a windowed image and a portion of a package wrapper image as required by the claimed invention.

Therefore, the reference to Jennel does not show or suggest the claimed concept of displaying a package wrapper image that includes a representation of at least a portion of a package wrapper that includes the windowed image thereon as shown, for example, in Figs. 7 and 8 of the present application. In Jennel, the image as a whole is displayed on display 22, and that image is sent to a site for printing. There is no showing or suggestion in Jennel of a preview of a package wrapper which includes the representation of a least a portion of a package wrapper that includes the windowed image thereon as required by the claimed invention.

The reference to Hinton was cited to show the concept of a user submitted image to produce a windowed image (see page 2, paragraph 3 of the Final Rejection). Applicant notes that the reference to Hinton does not correct the deficiencies of Jennel with respect to the claimed invention. More specifically, the reference to Hinton is directed to the concept of combining an image with a border, and providing each border with the ability to be deactivated and activated based on expiration dates. Page 2, paragraph 3 of the Final Rejection refers to Figs. 2-5 and col. 2, lines 59-62 of Hinton as showing a user submitted image and the production of a windowed image. Applicant notes that this section of Hinton as well as the remaining description in Hinton is not believed to describe or suggest this feature of the present invention. More specifically, the reference to Hinton provides for the input of an image 24 in a manner where it can be displayed on a display 20 (Fig. 2). As shown in Fig. 2 of Hinton, the image 24 can be displayed within a border 21. Thereafter, the customer can print the image with the border. There is no showing or suggestion in Hinton of a windowed image as shown in Fig. 5 of the present application. More specifically, in the present invention, window 42 can be provided within image 40 to create windowed image 44. The present invention provides for the ability to move the window 42 to select a specific windowed image that can be a portion of the submitted image. That windowed image 44 can then be used to produce a package wrapper as shown in Figs. 7 and 8 of the present application. This is different from Hinton which basically provides an image 24 with a border 21.

There is no showing or suggestion in Hinton that a window is to be provided on a portion of image 24. Also, absent Applicant's disclosure, one having ordinary skill in the art would not have modified the reference to Hinton to provide for the claimed arrangement.

Therefore, the reference to Hinton does not show or suggest the steps of claim 1, including the concept of displaying a user submitted image in a display area; providing a window on the image to provide a windowed image, with the window being movable relative to the image, and the windowed image comprising at least a portion of the image; and displaying a package wrapper image that includes a representation of at least a portion of a package wrapper that includes the windowed image thereon.

Further, absent Applicant's disclosure, one having ordinary skill in the art would not have been motivated to combine Jennel and Hinton to achieve the claimed invention, since neither reference shows or suggests the specific method of producing a personalized package wrapper as required by claim 1.

Additionally, even if Hinton and Jennel were combinable, the teaching of the combination would be to enable the placement of a border around an image. There would be no showing or suggestion of the specific method of claim 1 with respect to a windowed image and the production of a personalized package wrapper. Further, as noted above, Jennel simply shows the concept of displaying an image and sending an image to a printing site for the purposes of placing it on a wrapper. There is no showing or suggestion in Jennel of the specific method of claim 1 with regard to a personalized package wrapper that involves a windowed image.

On page 5, second full paragraph of the Final Rejection, it is suggested that the reference to Hinton discloses the "teaching of moving window to choose a border image", and therefore, it would be obvious to modify Jennel with Hinton's "moving window to simplify the step of choosing an image to be printed on the wrapping paper". Further, in the paragraph bridging pages 5 and 6 of the Final Rejection, it is suggested that Hinton discloses "the teaching of moving window to choose a border image". Again, Applicant notes that the reference to Hinton does not show or suggest the windowed image feature as required by the claimed invention and described in the present specification. That is, in Hinton, an image is inputted to the display 20 and, thereafter, a customer can access thumbnail files of available borders. The customer can select one of the borders for viewing with the displayed image 24. Once the composition of the

bordered image is acceptable, the customer can select to print the image. There is no showing or suggestion in Hinton or Jennel of providing an image 40 on a display as shown in Fig. 4 of the present application; and providing a specific window 42 on the image as shown in Fig. 5 of the present application. This claimed feature permits a customer to move window 42 around the entire image to select a specific portion of the whole image that is to be used for the package wrapper. This claimed feature is not shown or suggested in the applied references. Accordingly, contrary to what is set forth in the paragraph bridging pages 5 and 6 of the Final Rejection, the reference to Hinton is not believed to show or suggest the concept of moving a window within an image, since the reference to Hinton specifically sets forth that an image is placed on a display and then a customer chooses from a plurality of border images for the composite image. Absent Applicant's disclosure, there would have been no motivation to combine Hinton and Jennel as suggested in the Office Action, and, even if combinable, the combination would not show or suggest the specific features required by the claimed invention and discussed above.

Accordingly, Jennel and Hinton, whether considered individually or in combination, are not believed to show or suggest the features of claim 1.

ii. Arguments for dependent claims 2-3

Claims 2-3 depend from claim 1 and set forth further unique features of the present invention which are also believed to be allowable. More specifically, claim 2 requires that the method further comprises at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing of the package wrapper image in accordance the selected package wrapper size. Claim 3 requires that the method further comprise at least one of a printing, displaying, transmitting, and storing of the windowed image. The references to Jennel and Hinton, whether considered individually or in combination, are not believed to show or suggest the specific features of claims 2 and 3 in combination with the steps of claim 1 as discussed above. More specifically, the applied references are not believed to show or suggest the claimed feature of creating a windowed image, displaying a package wrapper image that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon, selecting a package wrapper size; and at least one of a printing of the package wrapper with the

window image thereon, a transmitting of the package wrapper image and storing of the package wrapper image in accordance with the selected package wrapper size; or at least one of a printing, displaying, transmitting and storing of the windowed image.

Therefore, claims 2-3 are believed to be allowable over the applied references.

iii. Arguments for dependent claim 5.

Claim 5 depends from claim 1 and further requires that the step of selecting the package wrapper size is accomplished by inputting dimensions of a package. This feature in combination with the steps of claim 1 is not shown or suggested in any of the applied references. Therefore, claim 5 is also believed to be allowable.

iv. Arguments for dependent claims 6-7.

Claim 6 depends from claim 1 and requires the further steps of selecting at least one predefined image from a plurality of predefined images; and combining the selected at least one predefined image with the windowed image. Claim 7 requires the further step of combining user generated personalized information with the windowed image. The applied references, whether considered individually or in combination, are not believed to show or suggest the concept of creating a windowed image as required by claim 1 and discussed above, in combination with the further steps of claim 6 with respect to selecting at least one predefined image and combining the one predefined image with the windowed image, or claim 7 with respect to combining user generated personalized information with the windowed image.

Therefore, claim 7 is also believed to be allowable.

v. Arguments for dependent claim 23.

Claim 23 depends from claim 1 and requires a computer storage product having at least one computer storage medium having instructions stored therein to cause one or more computers to perform the method of claim 1. Based on the reasons provided above with regard to claim 1, the applied references,

whether considered individually or in combination, are not believed to show or suggest a computer storage product having at least one computer storage medium with instructions stored therein to cause one or more computers to perform the steps of claim 1.

Therefore, claim 23 is also believed to be allowable.

vi. Arguments for dependent claim 24.

Dependent claim 24 relates to a personalized package wrapper produced by the method of claim 1. The applied references, whether considered individually or in combination, are not believed to show or suggest a personalized package wrapper made by the method of claim 1, the specifics of which have been discussed above.

Therefore, claim 24 is also believed to be allowable.

vii. Arguments for independent claim 8.

Claim 8 relates to a method of producing a personalized package wrapper that includes the steps of providing a window that is movable relative to an image provided by a user to produce a windowed image; forming a package wrapper image that comprises a representation of at least a portion of a package wrapper with the windowed image provided thereon; displaying the representation of the portion of the package wrapper comprised of the windowed image; selecting a package wrapper size; and performing at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing of the package wrapper image at the selected package wrapper size. As discussed above with respect to claim 1, the reference to Jennel does not show or suggest the claimed combination of a user submitted image and the placement of a window relative to the image to produce a windowed image which is a portion of the image, wherein the window is movable relative to the image. The reference to Jennel also does not show or suggest the steps of forming a package wrapper image that comprises a representation of at least a portion of a package wrapper with the windowed image provided thereon, and displaying the representation of the portion of the package wrapper comprised of the windowed image.

The reference to Hinton does not correct the deficiencies of Jennel with respect to the claimed invention. More specifically, Hinton discloses the concept of placing an image within a border but does not show or suggest the claimed specifics of the present invention for producing a personalized package wrapper; wherein a window is placed on an image to produce a windowed image, with the window being movable relative to the image. Therefore, even if combinable, Jennel and Hinton would not show or suggest the claimed features of the present invention. Further, absent Applicant's disclosure, one having ordinary skill in the art would not have combined the above-noted references to achieve the claimed invention, since neither reference shows or suggests the features of claim 8 as noted above.

With the arrangement of the present invention, it is possible to create a personalized package wrapper that utilizes a user submitted image. The present invention enables a further personalization by permitting a user to place a window on the user submitted image, move the window to a desired part of the user submitted image, and use this portion of the image to create the personalized package wrapper. This feature is not shown or suggested in any of the applied references, whether the applied references are considered individually or in combination.

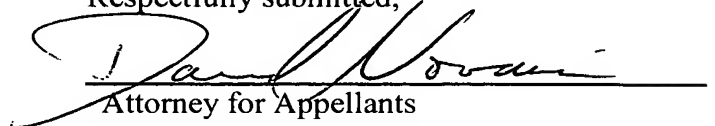
Therefore, the references to Jennel and Hinton, whether considered individually or in combination, are not believed to show or suggest the features of claim 8.

VIII. Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-3, 5-8, 23 and 24.

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Respectfully submitted,


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Appendix I - Claims on Appeal

1. A method of producing a personalized package wrapper that comprises at least one user submitted image, the method comprising the steps of:

displaying the user submitted image in a display area of an imaging device;

providing a window on said image to produce a windowed image, said window being movable relative to the image, and said windowed image comprising at least a portion of the image;

displaying a package wrapper image that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon;

selecting a package wrapper size; and

performing at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing the package wrapper image.
2. The method of Claim 1, further comprising at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing of the package wrapper image in accordance with the selected package wrapper size.
3. The method of Claim 1, further comprising at least one of a printing, displaying, transmitting, and storing of the windowed image.

5. The method of Claim 1, wherein the step of selecting the package wrapper size is accomplished by inputting dimensions of a package.

6. The method of Claim 1, further comprising the steps of:
selecting at least one predefined image from a plurality of predefined images; and
combining the selected at least one predefined image with the windowed image.

7. The method of Claim 1, further comprising the step of combining user generated personalized information with the windowed image.

8. A method of producing a personalized package wrapper,
comprising the steps of:
providing an imaging device having a display for displaying an image provided by a user;
providing a window which is movable relative to the image provided by the user to produce a windowed image, said windowed image being comprised of a portion of the image provided by the user;
forming a package wrapper image which comprises a representation of at least a portion of a package wrapper with the windowed image provided thereon;
displaying the representation of the portion of the package wrapper comprised of the windowed image;
selecting a package wrapper size; and

performing at least one of a printing of the package wrapper with the windowed image thereon, , a transmitting of the package wrapper image, and a storing of the package wrapper image at the selected package wrapper size.

23. A computer storage product having at least one computer storage medium having instructions stored therein causing one or more computers to perform the method of Claim 1.

24. A personalized package wrapper produced by the method of Claim 1.